DETAILED ACTION

1.   This office action is responsive to communications filed on 03/03/2004.

Claims 1-20 are pending and have been examined.

Specification

2.   The disclosure is objected to because of the following informalities:

On page 18, lines 5-10, applicant refers to "the executable object 172" on fig. 7,

but "the executable object 172" is not found in the fig. 7. Examiner believes applicant is

referring "the executable object 170" on the fig. 7.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

4.   Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

The phrase "instructing the client system to *at least one of obtain a document* at

a specified network address" recited in claim 1 is a relative phrase, which renders the

claim indefinite. It is unclear and vague to one of ordinary skilled in the art to interpret

the meaning of the phrase "*at least one of obtain a document* at a specified network

address".

Double Patenting

5.   The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees.   A nonstatutory
obviousness-type double patenting rejection is appropriate where the conflicting claims
are not identical, but at least one examined application claim is not patentably distinct
from the reference claim(s) because the examined application claim is either anticipated
by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140
F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29
USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.
1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422
F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ
644 (CCPA 1969).
       A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)
may be used to overcome an actual or provisional rejection based on a nonstatutory
double patenting ground provided the conflicting application or patent either is shown to
be commonly owned with this application, or claims an invention made as a result of
activities undertaken within the scope of a joint research agreement.
       Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).

6.   Claims 1-20 are provisionally rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over claims 1-20 of

copending Application No. 10/791940. Although the conflicting claims are not identical,

they are not patentably distinct from each other because the limitation "to build an

instruction message instructing the client system to at least one of obtain a document at

a specified network address and post data to a specified network address" recited in the

present application is an obvious variation of the limitation "to locate a second portable

document file that is related to the content selected by the user" recited on the

copending Application no. 10/791940. Both of the claims are directed in sending some

type of instruction based on the identifications of the document file and the displayed

data to locate another document file.

This is a <u>provisional</u> obviousness-type double patenting rejection because the

conflicting claims have not in fact been patented.

Claims of present application	Claims of pending application #: 10/791940
1. A method of operating a message server:	1. A method of operating a message server:
a) sending a first portable document file to a client system, the first portable document file comprising data content selectable by the user;	a) sending a first portable document file to a client system, the first portable document file comprising data content selectable by the user;
b) receiving a message, the message comprising both:	b) receiving a message, the message comprising both:
identification of the first portable document file; and	identification of the first portable document file; and
identification of the displayed data content selected by the user;	identification of the displayed data content selected by the user;
c) using the identification of the first portable document file and the identification of the displayed data content selected by the user to build an	c) using the identification of the first portable document file and the identification of the displayed data content selected by the user to

instruction message instructing the client system to at least one of obtain a document at a specified network address and post data to a specified network address; and
 	
    d) providing the instruction message to the client system.
	locate a second portable document file that is related to the content selected by the user; and
	
	    d) providing the second portable document file to the client system.

11. A message server for dynamically managing the relationship between portable document file content and related data processing systems, the message system comprising:
 	
    a) a web server module:
 	
        i) providing a first portable document file to a client system, the first portable document file comprising data content selectable by the user;
 	
        ii) receiving a message from the client system, the message comprising both:
 	
            identification of the
	11. A message server for dynamically managing the relationship between portable document file content and related portable document files, the message system comprising:
	
	    a) a web server module:
	
	        i) providing a first portable document file to a client system, the first portable document file comprising data content selectable by the user;
	
	        ii) receiving a message from the client system, the message comprising both:
	
	            identification of the

first portable document file; and	first portable document file; and
identification of the displayed data content selected by the user;	identification of the displayed data content selected by the user;
iii) providing an instruction message to the client system, the instruction message instructing the client system to at least one of obtain a document at a specified network address and post data to a specified network address; and	iii) providing a second portable document file to the client system, the second portable document file being related to the content selected by the user; and
c) a work flow module using the identification of the first portable document file and the identification of the displayed data content selected by the user to select an instruction for inclusion in the instruction message and to select the specified network address.	c) a work flow module using the identification of the first portable document file and the identification of the displayed data content selected by the user to locate the second portable document file.

Claim Rejections - 35 USC § 103

7.   **Claims 1, 6, 11 and 16** are rejected under 35 U.S.C. 103(a) as being

unpatentable over applicant **Admitted Prior Art**. Admission [See MPEP § 704.11 (a),

section (s), paragraph 4].

With respect to **claim 1,** Admission discloses a method of operating a message

server:

a) sending a first portable document file to a client system (Admission: page 1,

paragraph 3), the first portable document file comprising data content selectable by the

user (Admission: page 1, paragraph 5);

b) receiving a message, the message comprising both:

identification of the first portable document file (Admission: page 1,

paragraph 5, URL address); and

identification of the displayed data content selected by the user

(Admission: page 1, paragraph 6);

c) using the identification of the first portable document file and the identification

of the displayed data content selected by the user to build an instruction message

instructing the client system to at least one of obtain a document at a specified network

address and post data to a specified network address (Admission: page 1, paragraphs

5-8); and

d) providing the instruction message to the client system (Admission: page 1,

paragraphs 5-8).

With respect to **claim 6,** Admission discloses the method of operating a message server of claim 1, further comprising sending a message server address to the client system as a message server address update message that is a file distinct from the first portable document file, the message server address being an address at which the message is received (Admission, page 1, paragraphs 6 and 11, noted the POST command).

In regard to **claims 11 and 16,** the limitations of these claims are substantially the same as those in claims 1 and 6. Therefore the same rationale for rejecting claims 1 and 6 is used to reject claims 11 and 16. By this rationale **claims 11 and 16** are rejected.

Claim Rejections - 35 USC § 102

8.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9.   Claims **1-2, 6-7, 11-12 and 16-17** are rejected under 35 U.S.C 102 (e) as being anticipated by **Grober et al. (PGPUB: US 2004/0034831 A1).**

With respect to **claim 1,** Grober teaches a method of operating a message server (Grober, fig. 1):

a) sending a first portable document file to a client system, the first portable

document file comprising data content selectable by the user (Grober, page 4,

paragraphs 41-43, 48-49);

b) receiving a message, the message comprising both:

identification of the first portable document file (Grober, fig. 1, page 2,

paragraph 25, and page 4, paragraphs 43-44, noted the page identifier); and

identification of the displayed data content selected by the user (Grober,

page 2, paragraphs 25-26, and page 4, paragraphs 43-44, 48, noted the value

for the embedded tag);

c) using the identification of the first portable document file and the identification

of the displayed data content selected by the user to build an instruction message

instructing the client system to at least one of obtain a document at a specified network

address and post data to a specified network address (Grober: page 4, paragraphs 43,

noted the request to database); and

d) providing the instruction message to the client system. (Grober, fig. 1 and 3B,

page 5, paragraph 53).

With respect to **claim 2,** Grober teaches the method of operating a message

server of claim 1, wherein the step of using the identification of the first portable

document file and the identification of the displayed content selected by the user to build

an instruction message comprises:

i) utilizing work flow tables to map the identification of the first portable document

file and the identification of the displayed data content selected by the user to

identification of one of a plurality of objects, each for building a different type of instruction message (Grober: page 4, paragraphs 43-44);

ii) retrieving variables needs for calling the one of the plurality of object for building the instruction message (Grober, fig. 1 and 3B, page 4, paragraph 43 and page 5, paragraph 53); and

iii) making a processing call to the object (Grober: page 4, paragraphs 43-44).

With respect to **claim 6,** Grober teaches the method of operating a message server of claim 1, further comprising sending a message server address to the client system as a message server address update message that is a file distinct from the first portable document file, the message server address being an address at which the message is received (Grober, page 4, paragraph 48, and page 5, paragraphs 53-56).

In regard to **claim 7,** the limitations of this claim are substantially the same as those in claim 2. Therefore the same rationale for rejecting claim 2 is used to reject claim 7. By this rationale **claim 7** are rejected.

In regard to **claims 11-12, and 16-17,** the limitations of these claims are substantially the same as those in claims 1-2 and 6-7. Therefore the same rationale for rejecting claims 1-2, and 6-7 is used to reject claims 11-12 and 16-17. By this rationale **claims 11-12 and 16-17** are rejected.

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11.   Claims 3-5, 8-10, 13-15 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable **Grober et al. (PGPUB: US 2004/0034831 A1)** in view of **Steele et al. (Patent no.: US 7,016,877 B1).**

With respect to **claim 3,** Grober teaches the method of operating a message server of claim 1:

wherein the message further comprises identification of the user of the client system (Grober, fig. 3A, and page 4, paragraph 48).

However, Grober does not explicitly disclose a method using the identification of the user of the client system to determine whether the user has permissions to data processing systems at the specified network address; and the step of providing the instruction message to the client system comprises only providing the instruction message to the client system if the user of the client system has permissions to access the second portable document file.

In the same field of endeavor, Steele teaches a method of using the identification of the user of the client system to determine whether the user has permissions to data processing systems at the specified network address (Steele: fig. 2-4 & 12, col. 2, lines 53-64, and col. 9, line 58 to col. 10, line 52, noted the authorization ticket is granted to the user to access the information); and the step of providing the instruction message to the client system comprises only providing the instruction message to the client system

if the user of the client system has permissions to access the second portable document file (Steele: fig. 2-4 & 12, col. 9, line 58 to col. 10, line 52).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of granting an authorization ticket to users to access the information as taught by Steele in Grober's invention in order to provide an effective and strong information security by issuing the restricted access privileges to the users and ensure that the user using the ticket is authorized to do so (Steele: col. 10, lines 7-28).

With respect to **claim 4,** Grober teaches the method of operating a message server of claim 3, wherein the step of using the identification of the first portable document file and the identification of the displayed content selected by the user to build an instruction message comprises:

i) utilizing work flow tables to map the identification of the first portable document file and the identification of the displayed data content selected by the user to identification of one of a plurality of objects, each for building a different type of instruction message (Grober: page 4, paragraphs 43-44);

ii) retrieving variables needs for calling the one of the plurality of object for building the instruction message (Grober, fig. 1 and 3B, page 4, paragraph 43 and page 5, paragraph 53); and

iii) making a processing call to the object (Grober: page 4, paragraphs 43-44).

With respect to **claim 5,** Grober teaches all the claimed limitations except that he does not explicitly teach a method of utilizing the work flow tables to map the

identification of the user of the client system to an access level; comparing the access

level to a required access level; and providing the second portable document file to the

client system only if the access level is greater than or equal to the required access

level.

In the same field of endeavor, Steele teaches a method of utilizing the work flow

tables to map the identification of the user of the client system to an access level

(Steele: fig. 1-2 &12, col. 10, lines 29-64); comparing the access level to a required

access level (Steele: fig. 11, col. 10, lines 7-28, & col. 26, lines 8-35. Noted the step

1112); and providing the second portable document file to the client system only if the

access level is greater than or equal to the required access level (Steele: col. 10, lines

7-53). The same motivation that was utilized in the rejection of claim 3, applies equally

as well to claim 5.

In regard to **claim 8,** the limitations of this claim are substantially the same as

those in claim 3. Therefore the same rationale for rejecting claim 3 is used to reject

claim 8. By this rationale **claim 8** is rejected.

In regard to **claim 9,** the limitations of this claim are substantially the same as

those in claim 4. Therefore the same rationale for rejecting claim 4 is used to reject

claim 9. By this rationale **claim 9** is rejected.

In regard to **claim 10,** the limitations of this claim are substantially the same as

those in claim 5. Therefore the same rationale for rejecting claim 5 is used to reject

claim 10. By this rationale **claim 10** is rejected.

In regard to **claims 13-15 and 18-20,** the limitations of these claims are substantially the same as those in claims 3-5 and 8-10. Therefore the same rationale for rejecting claims 3-5 and 8-10 is used to reject claims 13-15 and 18-20. By this rationale **claims 13-15 and 18-20** are rejected.

Conclusion

12.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Chollon et al. (Patent no.: US 7,197,480 B1) discloses a method for front end business logic and validation.

- Haverstock et al. (PGPUB NO.: US 2001/0051985 A1) discloses a web server providing HTML pages embedded with non-HTML views.

- Dey et al. (Patent no.: US 6,996,775 B1) discloses a method for information retrieval using time-related multimedia.

- Kelley et al. (Patent no.: US 6,209,007 B1) discloses web internet screen customizing system.

- Alley et al. (PGPUB: US 2003/0078880 A1) discloses a method for electronically signing and processing digital documents.

13.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lin Liu whose telephone number is (571) 270-1447. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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